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EXAMINER

CADUGAN, ERICA E

ART UNIT	PAPER NUMBER
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3722

15

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/638,835

Applicant(s)

WEISS

Examiner

Erica E Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/30/2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the specification as originally filed does not appear to support that the attachment portion has “substantially no openings therein which would allow air into the interior of the attachment during operation of the power tool other than the opening for the spiral saw” as now set forth in independent claim 1.

Additionally, the specification as originally filed does not appear to teach that the forward edge of the workpiece “defines an opening for the spiral saw” as claimed in claim 1.

3. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, independent claim 1 now sets forth the limitation that the attachment portion has “substantially no openings therein which would allow air into the interior of the attachment during operation of the power tool other than the opening for the spiral saw”. However, it is

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noted that in order for the vacuum to be able to function as intended, it is noted that it would appear that there must inherently be some sort of openings other than the opening for the spiral saw. Note that, in operation, the edge of the opening for the spiral saw is pressed against the workpiece. Also note that in order for the vacuum to be able to function, it must pull air from somewhere, and to do that on a continual basis, there must then be some sort of opening that lets the air in.

Thus, firstly, as described in the new matter rejection above, the specification does not appear to support that there are “substantially no openings” in the attachment portion as claimed. Though the specification does not explicitly teach where any air inlet openings are located, they must inherently exist in some location in order for Applicant’s device to function as disclosed. If Applicant is asserting that such openings do not exist, then the disclosure does not appear to be enabling as it fails to teach how to use the device, i.e., since it does not appear that the vacuum would be able to function if there are no air inlet openings.

Further note that since the disclosure as originally filed does not specify where these openings are, to now assign a location where they are (or where they are not) constitutes new matter that was not supported by the disclosure as originally filed.

4. Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of claims 2-10 refers to “[t]he article” of a previous claim. However, no such “article” was previously set forth in the claims, rendering it unclear what limitations each of these claims includes. For the purpose of an analysis of the claims with respect to the prior art,

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Examiner is assuming that "[t]he article" should properly be --[t]he attachment--. However, note that these claims must still be amended to overcome this rejection.

***Claim Rejections - 35 USC § 102/103***

5. Claims 1-3, 5, and 10, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by German Pat. Doc. 3734127 (hereinafter '127) or, in the alternative, under 35 U.S.C. 103(a) as obvious over '127 in view of either of U.S. Pat. No.'s 5,323,823 (Kopras) or 5,143,490 (Kopras).

'127 teaches a machining tool 1 that is used to drive a helical or "spiral" (see Figure 1) tool bit 6. Element 29 is considered the claimed "first attachment portion", and element 31 in combination with tool body 2 is considered the claimed "power tool" and "forward" portion thereof (see Figures 1-2). Note that the bottom surface (as viewed in Figure 1) of element 29 rests on the workpiece 14 as the tool 6 machines the workpiece a desired depth "e" (see Figure 1), although there is nothing preventing '127's tool from being used to cut all the way through a workpiece if desired. Note that the relative longitudinal positions of elements 29 and 31 are adjustable, and that locking member 37 is used to fix them in a desired relative position for a desired depth of cut (Figure 1). Additionally, tube 22 serves as a "dust exit member" that angles upwardly (as viewed in Figure 1) from its point of connection to member 29. Note that tube 22 "communicates" with the interior space 19 of the member 29, and also that tube 22 is connected to a suction pump P (see Figure 1). As best understood, it does not appear that any edge of member 29 is used to "shear" material from the workpiece.

In Applicants' arguments filed 1/30, as best understood, it appears that the term "substantially" merely equates to an amount of openings that would not allow a large amount of

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dust to escape from the device (see bottom of page 4 of the response filed 1/30/04). Since the openings 23 taught by DE '127 appear to occupy less than half of the forward edge of the attachment portion 29, and since if they allowed a "large amount of dust" to escape, the attachment 29 would not be functioning as intended to remove the dust via the suction device P, as best understood, the openings 23 taught by DE 127 appear to constitute "substantially no openings" as claimed.

Specifically regarding claim 10, note that either of the inner or outer diameters of element 29 are considered to be "at least two" times the diameter of the shown tool bit 6, see figure 1.

In the alternative, if the spiral tool bit 6 shown is not considered the claimed "spiral saw bit", Kopras '490 teaches a spiral bit 14 and Kopras '823 teaches a spiral bit 20 (see Figure 2 of both patents). Kopras '490 specifically teaches that one advantage of that particular bit is that it has sufficient shear strength, even in a diameter as small as 1/8", to display much better resistance to breakage in use in comparison to prior bits (col. 2, lines 40-42, also col. 2, lines 1-8), and Kopras '823 specifically teaches the advantages that "it can be made in a diameter as small as 1/8" without an excessive breakage rate during use, yet can be quickly and easily guided along a cutting path in the sheet product without producing excessive burring along the top of the line of cut" (col. 2, lines 1-6, for example). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the specific bit taught by either of Kopras '490 or Kopras '823 for the bit taught by '127 for the purposes of providing a bit that is resistant to breakage (as taught by both Kopras '490 and '823 as described above), and which does not produce excessive burr along the top of the line of cut (as taught by Kopras '823 as described above).

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6. Claims 1-5, and 9-10, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Pat. No. 3,942,411 to Gerber or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gerber in view of either of U.S. Pat. No.'s 5,323,823 (Kopras) or 5,143,490 (Kopras).

In Gerber, a power tool has a "rigid attachment portion" 82, 86, 94, 92 that is adapted to be secured to the front end portion of a power tool in which a "helical edge" or "spiral saw" cutting tool is rotatably mounted (see Figure 4). The front end of the "rigid attachment portion" allows moving contact with the surface of a workpiece and "controls the depth of cut" of the tool. A "dust exit member" is provided for connection to a vacuum device (col. 5, lines 31-51, for example). Note that the set screw 96 is used for fixing the position of the member 82 with respect to the tool bit (figure 4).

It is also noted that in the device of Gerber, the interior diameter of the closed sleeve 86 must, to be operable as described in Gerber's description, have a diameter which is "greater" than the tool diameter to create a "space" between the tool 46 outside diameter and the diameter of the opening defined by plate 84. thus, the construction of Gerber's sleeve opening functions also to admit cut material, including any "dust" created in the cutting operation into a collection space upon which a vacuum is applied to remove cutting material. Thus, it appears that the interior diameter of the closed sleeve 86 may be considered to have a diameter "greater" to create a "substantial space" between the attachment portion and the "spiral saw".

Note also that Gerber appears to teach "substantially no openings" in the attachment portion "which would allow air into the interior of the attachment during operation of the power tool other than for the opening for the spiral saw" as claimed.

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Specifically regarding claim 4, note that the bracket 92 portion of the attachment has a “cylindrical section” with an internal diameter that connects to the power tool (Figures 3-4).

Specifically regarding claim 10, note that various portions of the attachment have external diameters that are apparently more than two times the diameter of the spiral saw (see fig. 4).

In the alternative, if the spiral tool bit shown is not considered the claimed “spiral saw bit”, Kopras ‘490 teaches a spiral bit 14 and Kopras ‘823 teaches a spiral bit 20 (see Figure 2 of both patents). Kopras ‘490 specifically teaches that one advantage of that particular bit is that it has sufficient shear strength, even in a diameter as small as  $1/8$ ’, to display much better resistance to breakage in use in comparison to prior bits (col. 2, lines 40-42, also col. 2, lines 1-8), and Kopras ‘823 specifically teaches the advantages that “it can be made in a diameter as small as  $1/8$ ” without an excessive breakage rate during use, yet can be quickly and easily guided along a cutting path in the sheet product without producing excessive burring along the top of the line of cut” (col. 2, lines 1-6, for example).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the specific bit taught by either of Kopras ‘490 or Kopras ‘823 for the bit taught by Gerber for the purposes of providing a bit that is resistant to breakage (as taught by both Kopras ‘490 and ‘823 as described above), and which does not produce excessive burr along the top of the line of cut (as taught by Kopras ‘823 as described above).

Also in the alternative, regarding claim 9, while it appears that the “dust exit member” is so dimensioned (see fig. 4), note that no criticality has been ascribed to the relative dimensions



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of the “dust exit member” and the “first attachment portion”, and thus it would have been an obvious matter of design choice to have made the different portions whatever relative sizes were desired, since such a modification would have involved a mere change in the proportions of components. A change in proportion is generally recognized as being within the level of ordinary skill in the art. In re Reese, 129 USPQ 402.

*Claim Rejections - 35 USC § 103*

7. Claims 4 and 7-9, and alternatively, claim 10, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over German Pat. Doc. 3734127 (hereinafter ‘127) or, in the alternative, as obvious over ‘127 in view of either of U.S. Pat. No.’s 5,323,823 (Kopras) or 5,143,490 (Kopras).

‘127, or alternatively, ‘127 in view of either Kopras ‘823 or Kopras ‘490 teaches all aspects of the claimed invention as described in the above rejection based thereon. However, regarding claim 4, in ‘127, the interior surface of element 31 and the exterior surface of element 29 form the “approximately dust-tight connection, instead of the interior surface of element 29 and the exterior surface of element 31. Additionally, regarding claim 7, ‘127 is silent about any “taper”. Additionally, regarding claim 9, and alternatively claim 10, ‘127 is silent as to the specific dimensions of the tube 22 and of any diameter of the member 29 and the tool 6.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have reversed the relative arrangement of parts 29 and 31 of ‘127 such that the interior surface of member 29 was used to form the “approximately dust-tight connection” with member 31 (instead of the current arrangement where the exterior surface of member 29 forms an “approximately

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dust-tight connection” with the interior surface of member 31) because Applicant has not disclosed that having the “interior surface” make the “approximately dust-tight connection” provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected both ‘127 and Applicant’s invention to perform equally well with these parts reversed because it doesn’t matter to the operation of either ‘127’s device or Applicant’s invention which member (31 or 29) is on the outside as long as the two members still form the “approximately dust-tight connection”, i.e., regardless of whether the ID (inner diameter) of 31 is larger than the OD (outer diameter) of 29 or whether the ID of 29 is larger than the OD of 31, as long as they are still arranged to form the “approximately dust-tight connection”, ‘127’s device will still serve to evacuate the machined debris via tube 22 (see Figure 1).

Therefore, it would have been an obvious matter of design choice to modify ‘127 (or ‘127 in view of either Kopras ‘823 or Kopras ‘490) to obtain the invention as specified in claim 4.

Regarding the dust exit member tube or hose, note also that a “slightly tapered” vacuum hose connection is common in vacuum hose connections and the use thereof for the instant vacuum attachment would not be unobvious as a design choice. Note also that Applicant has not ascribed any criticality to this feature. Also note that this assertion (that a “slightly tapered” vacuum hose connection and the use thereof is common in vacuum hose connections) is taken to be admitted prior art because Applicant did not

previously traverse the Examiner's assertion. See MPEP section 2144.03, section C, for example.

Regarding the relative dimensions of the dust exit member diameter and the first attachment portion (claim 9), note that no criticality has been ascribed to the relative dimensions of the "dust exit member" and the "first attachment portion", and thus it would have been an obvious matter of design choice to have made the different portions whatever relative sizes were desired, since such a modification would have involved a mere change in the proportions of components. A change in proportion is generally recognized as being within the level of ordinary skill in the art. In re Reese, 129 USPQ 402.

Regarding claim 10, in the alternative, while '127 does show in Figure 1 that either of the inner or outer diameters of the member 29 as being "several times" the diameter of the tool bit 6 (note that the spiral saw has plural diameters also, but that either of the diameters of the member 29 are "several times" any of the diameters of the bit 6), '127 is apparently silent as to the specifics of the relative dimensions of any tool diameter and any attachment portion diameter. However, again, Applicant has not ascribed any criticality to any diameter of the "attachment portion" being "several times" that of the diameter of the spiral saw. Thus, it would have been an obvious matter of design choice to have made the different portions whatever relative sizes were desired, since such a modification would have involved a mere change in the proportions of components. A change in proportion is generally recognized as being within the level of ordinary skill in the art. In re Reese, 129 USPQ 402.

8. Claims 7-8, and alternatively, claim 10, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber or, in the alternative, as obvious over Gerber in view of

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either of U.S. Pat. No.'s 5,323,823 (Kopras) or 5,143,490 (Kopras) as applied to claims 1 and 3 above.

Gerber, or alternatively, Gerber in view of either Kopras '823 or Kopras '490 teaches all aspects of the claimed invention as described in the above rejection based thereon. However, regarding claim 7, Gerber is silent about any "taper". Additionally, regarding claim 10, Gerber is silent as to the specific dimensions of the tool bit and the "attachment portion".

Regarding the dust exit member tube or hose, note also that a "slightly tapered" vacuum hose connection is common in vacuum hose connections and the use thereof for the instant vacuum attachment would be obvious as a matter of non-critical design choice. Note also that Applicant has not ascribed any criticality to this feature. Also note that this assertion (that a "slightly tapered" vacuum hose connection and the use thereof is common in vacuum hose connections) is taken to be admitted prior art because Applicant did not previously traverse the Examiner's assertion. See MPEP section 2144.03, section C, for example.

Regarding claim 10, in the alternative, while Gerber is apparently silent as to the specifics of the relative dimensions of any tool diameter and any attachment portion diameter. However, again, Applicant has not ascribed any criticality to any diameter of the "attachment portion" being "several times" that of the diameter of the spiral saw. Thus, it would have been an obvious matter of design choice to have made the different portions whatever relative sizes were desired, since such a modification would have involved a mere change in the proportions of components. A change in proportion is generally recognized as being within the level of ordinary skill in the art. In re Reese, 129 USPQ 402.

9. Claim 6, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over ‘127 or ‘127 in view of either of Kopras ‘823 or ‘490 as applied to claims 1 and 5 above, or alternatively, over ‘127 or ‘127 in view of either ‘823 or ‘490 above, and further in view of U.S. Pat. No. 3,786,846 (Mehring).

‘127, or ‘127 in view of either ‘823 or ‘490 teaches all aspects of the claimed invention as described in the above rejection based thereon, but does not teach the particular slot adjustment arrangement claimed in claim 6.

While ‘127 does teach that the members 29 and 31 are relatively longitudinally adjustable (see Figure 1, for example), and that they are fixed in a desired longitudinal position via locking member 37 to set the depth of cut “e” of tool 6 (see Figure 1), ‘127 does not teach the particular slot arrangement claimed. However, it is noted that slotted adjustment means of the instant device constitutes a known obvious design variant of the similar adjustment means described by ‘127 to allow selective axial adjustment of the distance that the tool extends beyond the end of the attachment portion. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted one known design variant for another, and specifically to have substituted the known slot arrangement for the arrangement taught by ‘127 depending on many design factors chosen by the designer, such as availability of parts.

In the alternative, Mehring teaches a machining device having an enclosure 22 at a bottom portion thereof, which enclosure includes a vacuum connection 56 connected to a flexible conduit 57 to collect and dispose machined chips (col. 3, lines 29-34, Figures 1-3). Additionally, connected to the lower enclosure 22 is a ledge 40 which has integral mounting tabs 41, 42, which are slotted at 43, and which are respectively secured by mounting screws 44 fitted with wing nuts

45 (Figures 1-3, col. 3, lines 1-12). The slots 43 enable the ledge 40 to be moved therealong, thus enabling tools of different lengths to be accommodated by the lower enclosure 22 (col. 3, lines 1-12, Figures 1, 3), via the bottoming engagement of ledge 40 against the spindle nose 16 of the device (see col. 3, lines 1-12, Figures 1, 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the slotted longitudinal adjustment arrangement taught by Mehring for the longitudinal adjustment arrangement taught by '127 for the purpose of providing a known functional equivalent, as evidenced by the teachings of Mehring, the selection of which is a design choice of the end user, absent a statement of criticality by Applicant (note that Applicant specifically teaches that "many diverse ways" could be employed to accomplish the adjustability between the cylindrical section and the mounting head, see page 3, lines 19-22, for example).

10. Claim 6, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber or Gerber in view of either of Kopras '823 or '490 as applied to claims 1 and 5 above, or alternatively, over Gerber or Gerber in view of either '823 or '490 above, and further in view of U.S. Pat. No. 3,786,846 (Mehring).

Gerber, or Gerber in view of either '823 or '490 teaches all aspects of the claimed invention as described in the above rejection based thereon, but does not teach the particular slot adjustment arrangement claimed in claim 6.

While Gerber does teach that the members 94/82 are relatively longitudinally adjustable with respect to member 92 (see Figure 4, for example), and that they are fixed in a desired longitudinal position via locking member 96 to set the depth of cut of the tool

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(see Figure r), Gerber does not teach the particular slot arrangement claimed. However, it is noted that slotted adjustment means of the instant device constitutes a known obvious design variant of the similar adjustment means described by Gerber to allow selective axial adjustment of the distance that the tool extends beyond the end of the attachment portion.

Note that this assertion (that the “slotted adjustment means of the instant device” constitutes a known type of adjustment means) is taken to be admitted prior art because Applicant did not previously traverse the Examiner’s assertion. See MPEP section 2144.03, section C, for example.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted one known design variant for another, and specifically to have substituted the known slot arrangement for the arrangement taught by Gerber depending on many design factors chosen by the designer, such as availability of parts.

In the alternative, Mehring teaches a machining device having an enclosure 22 at a bottom portion thereof, which enclosure includes a vacuum connection 56 connected to a flexible conduit 57 to collect and dispose machined chips (col. 3, lines 29-34, Figures 1-3). Additionally, connected to the lower enclosure 22 is a ledge 40 which has integral mounting tabs 41, 42, which are slotted at 43, and which are respectively secured by mounting screws 44 fitted with wing nuts 45 (Figures 1-3, col. 3, lines 1-12). The slots 43 enable the ledge 40 to be moved therealong, thus enabling tools of different lengths to be accommodated by the lower enclosure 22 (col. 3, lines 1-12, Figures 1, 3), via the bottoming engagement of ledge 40 against the spindle nose 16 of the device (see col. 3, lines 1-12, Figures 1, 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the slotted longitudinal adjustment arrangement taught by Mehring for the longitudinal adjustment arrangement taught by Gerber for the purpose of providing a known functional equivalent, as evidenced by the teachings of Mehring, the selection of which is a design choice of the end user, absent a statement of criticality by Applicant (note that Applicant specifically teaches that “many diverse ways” could be employed to accomplish the adjustability between the cylindrical section and the mounting head, see page 3, lines 19-22, for example).

#### ***Response to Arguments***

11. Applicant's arguments filed 1/30/2004 have been fully considered but they are not persuasive and/or are moot in view of the new ground(s) of rejection.

With respect to the German patent document 3734127, Applicant has asserted that because the DE '127 document teaches “inflow openings 23 in the area of the margin 21 of the boundary wall”, it does not meet claim 1, and further asserts that claim 1 requires that “there are no openings in the attachment device, other than the opening for the spiral saw, for allowing air into the attachment member during operation of the power tool”.

However, firstly, Applicant's attention is directed to the above rejections under 35 USC 112, first paragraph, based on the limitation regarding the lack of openings in the attachment for a detailed explanation of why the specification as originally filed did not support such a limitation, nor was it enabling for such a limitation.

Secondly, it is noted that Applicant's assertion does not quite accurately reflect the actual claim language of claim 1. Claim 1 does not set forth that the attachment portion has “no



openings...” as asserted, but rather that the attachment portion as “substantially no openings therein which would allow air into the interior of the attachment during operation of the power tool other than the opening for the spiral saw”. In Applicants’ arguments filed 1/30, as best understood, it appears that the term “substantially” merely equates to an amount of openings that would not allow a large amount of dust to escape from the device (see bottom of page 4 of the response filed 1/30/04). Since the openings 23 taught by DE ‘127 appear to occupy less than half of the forward edge of the attachment portion 29, and since if they allowed a “large amount of dust” to escape, the attachment 29 would not be functioning as intended to remove the dust via the suction device P, as best understood, the openings 23 taught by DE 127 appear to constitute “substantially no openings” as claimed.

With respect to the German patent document 3734127, Applicant has asserted that “the forward edge of the boundary wall 18 is not flat”. However, Applicant’s attention is directed to Figure 1 of ‘127. Note that the bottom or “forward” flat edge of the “attachment portion” 29 is flat and rests on the workpiece 9. Note that Figure 1 shows a cross section of the member 29. If Applicant is referring to the right and left angled portions at the lower end of member 29, then it is noted that these angled portions angle down to the forward “flat edge” as described, see Figure 1.

12. Additionally, Applicant has asserted that the “driven tool 6 extends beyond the forward edge of the boundary wall of the device, but does not extend a distance at least equal to the thickness of the workpiece to be cut by the spiral saw”.

Firstly, as set forth in the above (and previous) rejection based on DE ‘127, note that the bottom surface (as viewed in Figure 1) of element 29 rests on the workpiece 14 as the tool 6

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machines the workpiece a desired depth “e” (see Figure 1), although there is nothing preventing ‘127’s tool from being used to cut all the way through a workpiece if desired.

Note that the claim language in question actually sets forth that the first attachment portion is “structured and adapted to permit” (emphasis added) being secured in a selected position wherein the bit extends beyond the forward end of the first attachment portion “by a distance at least equal to that of the thickness of the workpiece to be cut by the spiral saw”. Via the ability of the member 29 to slide relative to the member 31 and tool bit (and to be secured in a new desired position via member 37), the device is considered to be so “structured and adapted to permit”. Thus, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the first rigid attachment portion is actually secured (rather than being just “structured and adapted to permit” such positioning) in a position wherein the bit extends beyond the forward end of the device by an amount at least equal to the workpiece thickness) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, it is noted that even if the claim was amended to so state that the attachment portion was secured in such a position, such a limitation would still not serve to define over DE ‘127 since the thickness of the workpiece is a matter of design choice of the end user and since the member 29 is able to be adjusted to whatever vertical (as viewed in Figure 1) location with respect to the tool is desired to have the tool bit project whatever amount is desired by the end user.

Also, note particularly that claim 1 is not directed to a combination of the attachment and particular workpiece, but just to the attachment (see claim 1, lines 1-2). Further note that such a combination (i.e., a claim directed to “an attachment and a workpiece”) would create other issues with respect to 35 USC 101 and 112 since 35 USC 101 requires that in order to be patentable, the invention must be a “new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof” (emphasis added). A claim that is drafted to embrace or overlap two different statutory classes of invention (in this case, “machine” and “manufacture”) is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See *Ex parte Lyell* (Bd Pat App&Int) 17 USPQ2d 1548.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Faxing of Responses to Office Actions and Contact Information***

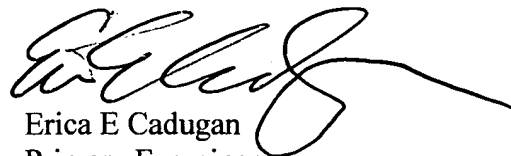
14. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica Cadugan whose telephone number is (703) 308-6395. The examiner can normally be reached on Monday through Thursday from 7:30 a.m. to 5:00 p.m., and every other Friday from 7:30 a.m. to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached at (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703) 308-1148.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Erica E Cadugan', with a long horizontal flourish extending to the right.

Erica E Cadugan  
Primary Examiner  
Art Unit 3722

eec  
April 7, 2004